

Patent

Attorney Docket No. Old: GEM-30890
New: GEMS8081.028

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : SINGH, Vikram et al.
Serial No. : 09/468,752
Filed : December 21, 1999
For : Method and Apparatus for Screening a
FAX RECEIVED : Potential Customer and Assigning an
MAY 06 2003 : Account Number to the Potential
GROUP 3600 : Customer Across a Global Computer
Network
Group Art No. : 3627
Examiner : Andrew J. Rudy

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

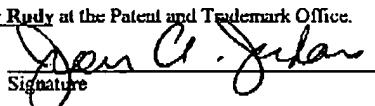
I hereby certify that, on the date shown below, this correspondence is being:

- deposited with the US Postal Service in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231
 with sufficient postage as first class mail As "Express Mail Post Office to Addressee" Mailing Label No.

Transmission

- transmitted by facsimile to Fax No.: 703-872-9327 addressed to Examiner Rudy at the Patent and Trademark Office.

Date: May 5, 2003


Signature

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

APPEAL BRIEF PURSUANT TO 37 C.F.R. §§1.191 AND 1.192

Dear Sir:

This Appeal Brief is being filed in furtherance to the Notice of Appeal mailed to the U.S. Patent & Trademark Office on March 35/40/2003 SCALLIHA 00000002 070845 09468752

01 FC:1402 320.00 CH

SINGH et al.

U.S. Serial No. 09/468,752

1. REAL PARTY IN INTEREST

The real party in interest is General Electric Company, the Assignee of the above-referenced application by virtue of the Assignment to General Electric Company recorded on April 14, 2000, at reel 010709, frame 0724.

2. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any other appeals or interferences related to this Appeal. The undersigned is Appellant's legal representative in this Appeal. General Electric Company, the Assignee of the above-referenced application, as evidenced by the documents mentioned above, will be directly affected by the Board's decision in the pending appeal.

3. STATUS OF THE CLAIMS

Claims 1-23 are currently pending, and claims 1-23 are currently under final rejection and, thus, are the subject of this appeal.

4. STATUS OF AMENDMENTS

The Appellant has not submitted any amendments subsequent to the Final Office Action mailed on December 3, 2002.

5. SUMMARY OF THE INVENTION AND OF THE DISCLOSED EMBODIMENTS

The present invention relates to screening transactions across a global computer network. *See Application* pg. 1, lns. 1-3. Specifically, the invention relates to a multi-tiered screening technique to determine whether a potential customer is qualified to purchase products/services. *Id.* pg. 3, lns. 2-12.

In accordance with one embodiment, the invention is a technique to screen a potential customer then assign an account number prior to permitting the potential customer to purchase products or services over a global computer network. *See Application* pg. 3, lns. 5-15. Furthermore, the invention provides a user interface for entry of customer data and access to an automated seller facility. *Id.* pg. 3, lns. 15-19. "If the potential customer passes the initial screening, an account number is issued" to allow the potential customer access to the automated seller facility. *Id.* pg. 3, lns. 23-25. During such access, the facility performs a second, complete, screening of the potential

SINGH et al.

U.S. Serial No. 09/468,752

customer to determine whether an offer to purchase products/services will be accepted from the potential customer. *Id.* pg. 4, lns. 1-2 and pg. 16, lns. 11-14.

In accordance with another embodiment, the invention is a network-based system for implementing the steps described above. *See Application* pg. 4, lns. 3-16. Also, in accordance with yet another embodiment, the invention is a computer readable medium having thereon a computer program that, when executed, causes one or more computers to accomplish the above described steps. *Id.* pg. 4, lns. 17-26.

6. ISSUES

Issue No. 1:

Whether claims 1-23 are unpatentable under 35 U.S.C. §103 over Hinh et al. (USP App. Pub. No. 2001/0042026).

Issue No. 2:

Whether claims 1-23 are unpatentable under 35 U.S.C. §103 over Westrope et al. (USP 5,968,110).

7. GROUPING OF CLAIMS

The Examiner has provided two separate grounds of rejection which Appellant contests. The claims of the groups do not all stand or fall together.

8. ARGUMENT

As discussed in detail below, the Examiner has improperly rejected the pending claims. The Examiner has misapplied long-standing and binding legal precedents and principles in rejecting the claims under Section 103(a). Accordingly, Appellant respectfully requests full, favorable consideration by the Board, and ultimate allowance of claim 1-23 as Appellant believes that claims 1-23 are currently in condition for allowance.

Issue No. 1:

Claims 1-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over a single reference, Hinh et al. The Examiner has grouped all pending claims together in one group. However, claims 1-23 are patentable because the Examiner has failed to establish a *prima facie* case of obviousness. Furthermore, claims 1-23 do not necessarily stand or fall together because, as will be shown below, claims 1-3, 6-10, and 12-23, include subject matter that is each believed patentably distinct from the art of record.

SINGH et al.

U.S. Serial No. 09/468,752

Accordingly, Appellant respectfully believes that claims 1-3, 6-10, and 12-23 must be reviewed independently to decide the appeal.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. To establish a *prima facie* case, the Examiner must not only show that the reference teaches or suggests each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §2142 quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Intcr. 1985). The Examiner has failed to show that Hinh et al. teaches or suggests each and every element of the claimed invention. Furthermore, the Examiner has failed to provide a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references.

The Examiner stated in the Office Action mailed on July 15, 2002, that:

Hinh illustrates a secure interactive method of screening a potential customer for the purchase of a product via a computer database. Credit worthiness may be ascertained if the credit limit is permitted to purchase the product. Hinh's database may be updated. To issue an account number after credit worthiness is established for Hinh would have been obvious to one of ordinary skill in the art. Doing so would use well known credit history database technology to ascertain whether a business entity desires to complete a sale with a potential customer.

Office Action of July 15, 2003, pg. 2, ¶ 2, lns. 2-8.

Appellant respectfully believes that the Examiner has erroneously considered that which is claimed as equivalent to Hinh et al.'s credit worthiness check. Appellant does not argue that Hinh et al. teaches a check of credit worthiness but such is not the claimed invention. Specifically, Appellant showed that Hinh et al. discloses an internet purchasing system including an address verification and a determination as to whether sufficient funds are present in the customer's provided account, both of which are consistent with a common credit check. *See Response* of September 16, 2002. However, the Examiner has removed fragments of Hinh et al. from the context and purpose of Hinh et al. to construct a disjointed rejection that does not address the specific elements of the claimed invention. Specifically, it must be remembered that Hinh et al. teaches "methods for providing a customer with a printer-outputted, encodable printed verifiable proof of

SINGH et al.

U.S. Serial No. 09/468,752

purchasc for a product or service made over the internet." Hinh et al. at ¶ [0002]. That is, Hinh et al. teaches a system for generating a printed verifiable proof of purchase for typical internet sales. Hinh et al. is not directed to, nor does it teach, the claimed invention for screening a potcntial customer and assigning an account number to the potential customer across a global computer network.

Hinh et al. does not include the claimed two-tier screcning system presently claimed, but rather a simple login and, in conjunction with a finalized sale, a credit check. Hinh et al. teaches the use of "codes and routines...well known in the art" to verify a login and collect customer information. Hinh et al. at ¶ [0019]. Such a username and password login is consistent with e-commerce establishments, but Appellant does not purport to have invented the username/password-login concept. It is well known in the art that such a login is implemented in order to simplify the ordering process for the customer by reducing the amount of redundant customer information entered but does not entail a screening to determine qualification to purchasc goods and/or services. On the other hand, the claimed invention is specifically drawn to screening potential customers in a two-tiered system to determine whether the potential customer is qualified to make an offer to purchase. *See Response of September 16, 2002.*

Independent Claim 1

Regarding claim 1, the Examiner did not demonstrate that the reference teaches or suggests each and every clment of the claimed invention. In the Final Office Action of December 3, 2002, the Examiner contends that:

Appellant has claimed potential use, e.g. claim 1, lns. 4, 5 "for a potential customer to access an automated seller facility"...and no concrete two-tier screening methodology to execute the method is recited. An initial screening may be no more than placing an person/entities name on a credit application. A log-in may also broadly constitute a prescreening. Further, the credit check industry contains a prolific list of data used to screen potential customers, e.g. location of potential customer, completeness of application, and implementing such in the present scenario is deemed within the purview of one of ordinary skill in the art.

Office Action of December 3, 2002; pg. 2, ¶ 2, lns. 3-10 and ¶ 3, lns. 1-3.

While it is true that the claim includes a certain degree of "potential use," claim 1 is a method of screening a potential customer after all. Therefore, the step of

SINGH et al.

U.S. Serial No. 09/468,752

providing a user interface for a potential customer includes a degree of potential use since the claims is not literally calling for a customer. However, the element does specifically call for providing a user interface to access an automated seller facility that takes place over a computer network, and the user interface is specifically called for allowing the customer to enter customer data for qualification checking by a seller. This "level" of potential use is not to be confused with the adjective 'potential' that describes a person or entity that is not yet a "customer," which is not the same as "potential use." *Id.* This is a term to describe one who has not yet been accepted to engage in a commercial transaction, and this is not yet a customer. *Id.* The adjective "potential" only modifies the noun "customer" because, until qualified, this person or entity is not a "customer."

The Examiner strays from that which is taught or suggested by the reference into the hypothetical. The Examiner appears to be reading the claims, not in light of *Appellant's* specification, but in light of the reference specification. For example, the Examiner states that "[a] log-in may also broadly constitute prescreening." Office Action of December 3, 2002; pg. 2, ¶ 2, ln. 7. However, no support for the assertion is found in *Hinh et al.* and the Examiner provided no other reference with *Hinh et al.* in support of the §103 rejection. It will be described below in detail as to why this is not the case.

This position ignores the specific limitations of the claim. Claim 1 calls for, in part, "performing an initial screening of the potential customer to determine whether the potential customer is qualified to purchase products/services from the seller..." While the Examiner has not provided a reference to substantiate the rejection, the Examiner cites to his general knowledge of user names and passwords as being a form of screening. While this may be true, a user name and password is generally to identify a user, without qualification. That is, to identify that a person is the person who previously logged on with that user name, but it does not require a qualification check. It is not a process of performing an initial screening to determine whether that person is qualified to purchase certain products/services from a seller. Appellant contends that one skilled in the art will readily recognize that there is no "initial screening" in obtaining a user name and password.

SINGH et al.

U.S. Serial No. 09/468,752

Nevertheless, the claim includes yet other distinctions, that when read as whole, is clearly not taught, or suggested by the prior art cited by the Examiner.

The Examiner has actually highlighted several distinctions between the claimed invention and that which is taught by Hinh et al. Specifically, while Hinh et al. teaches a system that may be consistent with credit checks or login/password combinations, claim 1, in part, calls for "...performing an initial screening of the potential customer to determine whether the potential customer is qualified to purchase products/services from the seller" and "if the customer passes the initial screening, thereby allowing the potential customer... to make an offer to purchase products/services... while the automated seller facility performs a complete screening." Therefore, claim 1 calls for a method of screening potential customers through what amounts to a two-tier method where the initial screening is conducted and must be passed prior to allowing the potential customer access to the automated seller facility to make an offer to purchase while a second, more complete, screening is performed. Only following a satisfactory completion of an initial screening, to determine if the potential customer is even qualified, is a potential customer permitted further access to the automated seller facility to make an offer to purchase while the second more complete screening is conducted. *See Response of September 16, 2002.*

One of ordinary skill in the art will readily recognize that the claimed invention is not a simple username-password check or a credit check and does not read on one. That is, claim 1 calls for performing the initial screening of the potential customer "to determine whether the potential customer is qualified to purchase products/services from the seller..." and only if that initial screening is passed, is an account number issued to allow performance of a second screening. The initial screening called for in claim 1 is specifically "to determine whether the potential customer is qualified to purchase products/services from the seller." While the Examiner equates this with a username and password, one of ordinary skill in the art will recognize that username-password checks are merely implemented to "identify" a pre-registered user and not to see if that particular user is qualified to purchase products/services from the seller.

Regardless, there is no suggestion in Hinh et al. to perform yet a more complete screening while the potential customer is given access to the automated seller facility to

make an offer to purchase products/services. Hind et al. states that only after "the customer chooses to complete the purchase... a check is made of the customer's account information." *See* *Hinh et al.* at ¶ [0023] and Response of September 16, 2002. The Examiner equates the claimed, second screening to the credit check of *Hinh et al.* *See* Office Action of December 3, 2002. However, *Appellant*'s disclosure defines numerous examples of this second screening such as checking whether additional terms or comments have been added to the contract, whether the order size is exceeding a reasonable limit, if appropriate credit lines have been provided, whether the potential customer is included on a list of individuals and entities excluded from such purchases, if the product the customer is interested in is permitted within the geographical region of the customer, and other attributes associated with a complete screening. *See* *Appellant*'s Specification, pgs. 9-11. A credit check alone is not consistent with such a "complete screening." While relevant case law has consistently held that claims may be interpreted in light of the "Appellant's" disclosure, the Examiner interprets the claims of the present application only in light of the prior art reference. *See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430 (Fed. Cir. 1988). Appellant believes that the Examiner has actually ignored the specification of the present application in favor of interpreting claim language so as to reject the claims and without regard to proper claim interpretation.

Nonetheless, the Examiner's assertions are contrary to that which is explicitly taught by *Hinh et al.* That is, *Hinh et al.* teaches that "[i]f the customer chooses to complete the purchase, the customer's acceptance is processed." *Hinh et al.* at ¶ [0023]. Therefore, *Hinh et al.* teaches directly away from "receiving the customer data from the customer in the automated seller facility via the user interface and over the computer network and performing an initial screening of the potential customer to determine whether the potential customer is qualified to purchase products/services from the seller" because *Hinh et al.* teaches allowing the customer, not the seller, to choose whether to complete the purchase. In the present claims, it is the seller who decides as to whether or not the customer/potential customer is allowed to even make an offer to purchase products from the seller.

Also, claim 1 is explicit that the potential customer is only permitted to "make an offer to purchase products/services." Claim 1 does not call for allowing a customer purchase. On the other hand, Hinh et al. is specifically directed to methods of purchasing, as dictated by the customer. *See* Hinh et al. at ¶ [0023]. As stated, the claimed invention is directed to a two-tier system for screening customers prior to any acceptance of an "offer" to complete a purchase. In Hinh et al., it is the buyer/purchaser who has control of the purchase, whereas in the present claim, it is the seller who has control of the purchase, and merely allows the purchaser to make an offer to purchase while performing the more complete screening.

Assuming arguendo that Hinh et al. teaches an initial screening and a second screening, the Examiner still has failed to show that the reference teaches or suggests each and every element of the claimed invention. Specifically, the second screening performed by Hinh et al., i.e. the credit screening, is initiated only after an offer to purchase has been made by the customer and is more akin to Appellant's initial "qualification" screening. That is, a customer must select an item to purchase before a credit screening can be initiated and the customer is then qualified to purchase. One of ordinary skill in the art will readily recognize, and the Examiner has identified, credit worthiness cannot be checked until "the product" is identified and therefore, "the product's" price, is identified. That is, one of ordinary skill will readily recognize that one cannot determine whether a potential customer has sufficient credit to purchase "the product" until the price of "the product" is known. However, claim 1 is specific that the second, complete screening occurs while the potential customer is permitted to make an offer to purchase. This can occur only because of the initial qualification screening that determines whether the potential customer is even qualified to purchase products/services from the seller. A reading of claim 1, as a whole, and in light of the Specification, clearly defines patentable subject matter over Hinh et al. not only because the second screening implemented while the product/service is identified by the potential customer, but also claim 1 calls for a complete screening after the initial qualification screening. For these reasons, it is possible to implement the complete screening while the potential customer makes an offer to purchase.

SINGH et al.

U.S. Serial No. 09/468,752

Additionally, the Examiner asked:

Where in the claim language is it positively recited that initial screening does not preclude access of the seller facility prior to the initial screening? The Examiner does not read such positive recitations in the present claim language.

Office Action of December 3, 2002; pg. 2, ¶ 2, lns. 3-10 and ¶ 3, lns. 1-3.

However, Appellant does not contend that it is positively recited that the initial screening does not preclude access of the seller prior to the initial screening. To the contrary, the claimed invention does preclude access of the seller prior to the initial screening. That is, claim 1, and subsequent claims, recite that the potential customer is precluded from further access to the seller facility unless the initial screening is passed in that Appellant recites, in claim 1, for example, that an account number is issued “if the potential customer passes the initial screening, thereby allowing the potential customer further access to the automated seller facility...” Claim 1, lns. 13-15. Therefore, it appears the Examiner is confused as to what is claimed. Appellant believes this confusion is indicative of an incorrect basis upon which the current rejection is predicated, and is also indicative of forcing a reading of the claims on the prior art, as opposed to interpreting the claims in light of the Specification.

For all of the reasons stated above, Appellant believes claim 1 is patentably distinct over the cited reference. Appellant believes claims 2-11 are in condition for allowance at least pursuant to the chain of dependency. However, since Appellant believes claims 2-10 to include subject matter that is additionally distinguishable from the art of record, Appellant will specifically address that which is patentably distinct above and beyond the allowability of the claims pursuant to the chain of dependency.

Claims Dependent on Claim 1

The Examiner did not address the specific limitations of the dependent claims and therefore did not establish a *prima facie* case for obviousness. The Examiner must not only show that the reference teaches or suggests each and every element of the claimed invention, but also provide “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP §2142 quoting Ex parte Clapp, 227 USPQ 972,

973 (Bd. Pat. App. & Inter. 1985). By not addressing the majority of elements of claims 2-11, other than to state that they are rejected, Appellant believes the Examiner has not met the burden established. Furthermore, Appellant contends that these claims each contain subject matter that is patentably distinct from the art of record and require independent review.

Specifically referring to claim 2, Hinh et al. fails to teach “accepting the potential customer’s offer to purchase products/services only if the potential customer passes the complete screening and thereby only entering into a contract with the potential customer once the seller is satisfied the potential customer is qualified to purchase the products/services.” Nowhere does Hinh et al. teach this sequence of steps for “entering into a contract with the potential customer.” The Examiner does not set forth a detailed explanation as to why this claim is pre-empted by the art cited. Hinh et al. does not teach these elements and this use of service/sales contracts. Furthermore, the Examiner failed to address the elements of claim 2 despite Appellant’s insistence that claim 2, like other dependent claims, contain patentable distinct subject matter. As such, the Examiner has failed to meet the burden required to establish a *prima facie* case of obviousness. Accordingly, Appellant believes claim 2 is patentably distinct from the art of record.

Regarding claim 3, the Examiner again neglected to address each and every element of the claim. Rather, the Examiner rejected the claim without analysis of the elements. Claim 3, in part, calls for “receiving an existing account number and providing a pre-populated user interface in response thereto having existing customer data therein, and requiring verification of the existing data by the potential customer, thereby bypassing the initial screening step.” As stated, the Examiner failed to specifically address the elements of claim 3. However, applying the Examiner’s relevant remarks regarding the omnibus rejection of claims 1-23, it is clear that the Examiner has failed to establish a *prima facie* case of obviousness and simply based the rejection on a blatant misconception of the prior art.

It is initially noted however that the Examiner’s rejection cannot stand as it is inconsistent as applied to claims 1 and 3. That is, the Examiner appears to contend that

the initial screening in claim 1 could be nothing more than a login and password, but claim 3 specifically allows the bypassing of the initial screening step. Claim 3 also adds the step of receiving an existing account number in providing a pre-populated user interface, which is more akin to a user name and login. With that being the case, under the doctrine of claim differentiation, this dictates that the initial screening could not be the same user name and password login. The Examiner makes blanket statements for all the claims, and by not addressing specific claim limitations, has not met the burden required to find the claims obvious. Further, Appellant is at a disadvantage in responding to rejections that do not address the specific claim limitations. As an example, it is unclear if the Examiner is interpreting the initial screening or the complete screening as being a credit check, and if it is the initial screening, then the Examiner appears to interpret the initial screening in two different ways. This problem is illustrated in the following two paragraphs.

In rejecting claims 1-23 as a whole, the Examiner asserts that “[a]n initial screening may be no more than placing a[n] person/entities name on a credit application” or that “[a] log-in may also broadly constitute a prescreening.” Office Action of December 3, 2002. As shown with respect to claim 1, the Examiner’s assertion is incorrect. However, the Examiner’s misconception of the claimed invention is further illuminated when applying it to the elements of claim 3. Extending the basis of rejection to provide a detailed rejection of claim 3, one of ordinary skill in the art will recognize that the initial screening is not a login or a credit check. That is, beyond the fact that logins and credit checks are inconsistent with that which is called for in claim 1, that which is called for in claim 3 further illustrates the inconsistencies in the rejection.

On the other hand, if the Examiner’s statement that the initial screening could be a credit screening is extended to claim 3, then claim 3, in part, calls for allowing the credit check to be bypassed upon receiving of an existing account number. However, Hinh et al. teaches directly away this. Specifically, Hinh et al. teaches the use of the CServicePurchasing class, which is specifically described to include the code that implements the “verify[ing of a] customer credit card for charge of that amount.” Hinh

SINGH et al.

U.S. Serial No. 09/468,752

et al. at ¶ [0023], Fig 4 and Annex Part E. Examining the code provided in the Annex of *Hinh et al.*, one of ordinary skill in the art will recognize that included within the *CServicePurchasing* class are calls to the *IServicePurchasing* and *IServiceProofing* routines, which are called by the *CServicePurchasing* class to actually perform the “verify[ing of a] customer credit card for charge of that amount.” *Id.* *Hinh et al.* provides no basis to bypass the *CServicePurchasing* class in order to “bypass[] the initial screening” because doing so would eliminate the call to the *IServicePurchasing* routine. That is, bypassing a call to *IServicePurchasing* would remove the code that implements purchasing. Therefore, by extending the Examiner’s rejection to specific elements of claim 3, one of ordinary skill in the art will readily recognize that *Hinh et al.* teaches away from bypassing the step of verifying credit worthiness because doing so would circumvent the purchase process and render *Hinh et al.* inoperable since the “verifying” and “purchasing” are called by the same class. Accordingly, that which is called for in claim 3 further illustrates that the rejection is unsustainable.

Alternatively, if the initial screening is equated with a simple login, then claim 3, in part, calls for providing a pre-populated user interface in response to receiving an existing account number having existing customer data therein, and requiring verification of the existing data by the potential customer, thereby bypassing the login. However, one of ordinary skill in the art will readily recognize that such is contradictory. That is, if a potential customer is required to enter an account number, the customer has entered some kind of login. Therefore, how can a potential customer bypass a login by completing a login? Simply, the initial screening called for in claim 1 cannot possibly be a simple login and therefore, the initial screening may be bypassed upon receipt of an existing account number. Accordingly, Appellant believes the Examiner has not established a *prima facie* case of obviousness. Therefore, Appellant believes claim 3 is patentably distinct from the art of record.

Regarding claim 6, the Examiner again failed to address each and every element of the claim. Claims 6, in part, calls for “sending the account number, together with a password, and an electronic contract to the potential customer after the potential customer has passed the initial screening.” As previously stated, *Hinh et al.* does not

teach the use of such a contract, let alone sending a contract to a potential customer along with an account number and password. Furthermore, Hinh et al. does not teach any such steps to be completed “after the potential customer has passed the initial screening.”

Again, extending the Examiner’s assertions regarding the rejection of claims 1-23, to the specific language of claim 6, further illustrates the Examiner’s misconceptions regarding the current invention and what is taught by Hinh et al. These misconceptions arise from an attempt to read the claims in light of the prior art, instead of interpreting the claims in light of the Appellant’s specification. The Examiner asserted that the initial screening may be a simple login. *See* Office Action of December 3, 2002. However, one of ordinary skill will readily recognize that “sending the account number, together with a password, and an electronic contract to the customer” is not consistent with entering a standard login. As such, one of ordinary skill in the art will recognize that the “initial screening” called for in claim 6 is not a simple login. Furthermore, though Hinh et al. teaches the use of a common credit check and assuming the second screening is the credit check, Hinh et al. does not teach that an account number, together with a password and electronic contract, be sent to the customer after completing the credit check. The Examiner never addressed these claim limitations. Rather, Hinh et al. is concerned with printing a verifiable proof of purchase, as is the object of the invention of Hinh et al. Therefore, Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness and, therefore, claim 6 is patentably distinct from the art of record.

Regarding claim 7, the Examiner again failed to address each and every element of the claim. Claim 7, in part, calls for “segregating products/services into restricted and unrestricted product categories.” Nowhere in Hinh et al. is product/service segregation taught nor are restricted and unrestricted product categories taught. The Examiner completely failed to address this limitation of claim 7. That is, the Examiner has rejected claim 7 and never, in three separate actions, addressed “segregating products/services into restricted and unrestricted product categories.”

Furthermore, claim 7, in part calls for "checking the customer data to clear any red flags." Nowhere in Hinh et al. are red flags taught nor is the clearing thereof taught, or suggested. The Examiner has failed to address the checking and/or clearing of flags in any action. The Examiner made no attempt to address the elements of claim 7. Hinh et al. does not teach such. Accordingly, Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness and that claim 7 is patentably distinct from the art of record.

Regarding claim 8, the Examiner again failed to address each and every element of the claim. Claim 8, in part, calls for the restricted product category to include "at least one of: medical equipment, product/service information pertaining to medical equipment, and medical equipment service." As previously stated, Hinh et al. does not teach restricted product categories. Furthermore, Hinh et al. does not teach medical equipment, product/service information pertaining to medical equipment, and medical equipment service. Simply, nowhere is medical equipment of any kind discussed by Hinh et al. The Examiner failed to address the elements of claim 8. As one skilled in the art will readily recognize, the general public cannot have unfettered access to such medical equipment, and therefore, there is a need for qualification checking of the potential customers. Accordingly, Appellant believes that claim 8 is patentably distinct over the art of record.

Regarding claim 9, the claim, in part, calls for the clearing of red flags. As previously stated, Hinh et al. does not teach the use of flags. As such, Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness, and that claim 9 is patentably distinct over the art of record.

Regarding claim 10, the Examiner did not address the limitations found in the claim. Claim 10, in part, calls for the complete screening to include "checking whether the potential customer has changed any terms and conditions defined by the seller in an offer to purchase products/services, and if so, ensuring that such changes are satisfactory to the seller." Again, the Examiner has completely failed to provide a basis of rejection of claim 10. Hinh et al. does not teach that which is claimed. However, extending the Examiner's remarks regarding the omnibus rejection of claims 1-23 as a

SINGH et al.

U.S. Serial No. 09/468,752

whole to the specific language of claim 10, one of ordinary skill in the art will recognize that common online credit checks do not include checking whether the customer has changed terms and conditions, let alone even allowing the customer the opportunity to make such changes to the terms and conditions of an electronic contract. That is, the credit check taught by Hinh et al., or those consistent with e-commerce, do not include checking and accepting, if satisfactory to the seller, changes the potential customer might have made to any of the terms and conditions defined by the seller. Such credit checks do not typically allow the potential customer to change any of the terms and conditions defined by the seller. Therefore, Appellant believes the Examiner has completely failed to establish a *prima facie* case of obviousness. Accordingly, Appellant believes claim 10 is patentably distinct over the art of record.

Independent Claim 12

Regarding claim 12, the Examiner also failed to address the specific limitation of the claim. That is, claim 12 was included in the Examiner's rejection of claims 1-23 and addressed in the general remarks stated above. However, the Examiner did not specifically address the elements of claim 12.

In response to the Examiner's general rejection of claims 1-23 in the Office Action of July 15, 2002, Appellant addressed numerous specific elements of claim 12 that are patentably distinct from the art of record. Specifically, in the Response of September 16, 2002, Appellant stated:

Claim 12 calls for a program that requires an initial screening to be passed prior to access to the automated seller facility. Nowhere does Hinh et al. teach that the login information is used as a precursor to access to the catalog but rather it implies that the login is implemented in order to simplify the order process for the customer. Also, Annex D of '42026 teaches only an address verification. As such, Hinh et al., when referring to checking the customer's account information and referring to the codes contained in Annex D, is only referring to an address check. Hinh et al. at ¶23. Furthermore, Annex E of '42026 adds code to verify customer credit availability of the amount necessary to purchase the product but the codes disclose a check only equivalent to common credit check procedures.

Claim 12 calls for issuance of an account number if the potential customer passes the initial screening, wherein the account number allows the potential customer to further access the automated seller facility. Hinh et al. does not disclose the issuance of an account number after an initial

SINGH et al.

U.S. Serial No. 09/468,752

screening and before the completion of a more thorough screening as called for in claim 12. Claim 12 specifically calls for conducting a complete screening while simultaneously allowing the potential customer to place a product/service order. Even assuming that the initial screening called for in claim 12 could be a username and password, Hinh et al. does not disclose issuing an account number after the initial screening, and before the complete screening. Further, even if one were to assume that the complete screening could be a credit check, there is no disclosure or suggestion that the complete screening be conducted while simultaneously allowing the potential customer to place a product/service order. Hinh et al. discloses a credit card check after the potential customer places a product/service order.

Response of September 16, 2002; pg. 4, ¶ 2.

In response to Appellant's remarks, the Examiner again failed to address the elements of claim 12 or show how Hinh et al. teaches or suggests all the limitations of claim 12. Instead, in the Final Office Action of December 3, 2002, the Examiner simply stated that "Appellant's comments regarding claim 12 are noted, but not convincing as no such claim limitations are present in the claims as so argued in the REMARKS." Pg. 3, ¶ 1, lns. 3-5.

Appellant believes that the limitations are, and were, present in claim 12, as argued. For example, claim 12 is specific that an initial screening is performed, and "if the potential customer passes the initial screening," then the potential customer is allowed to further access the automated seller facility. While Appellant summarized the limitation as "require[ing] an initial screening to be passed prior to access to the automated seller facility," Appellant believes such a summary to be entirely consistent with the elements of claim 12. *Id.* at pg. 4, ¶ 2, lns. 1-2.

Additionally, claim 12 clearly calls for "a complete screen while simultaneously allowing the potential customer to place a product/service order." In the Appellant's remarks (recited above), *Appellant* made a near verbatim recitation of the actual claim limitation. As such, Appellant believes the limitations argued are indeed present in the claim. As such, Appellant believes the original Remarks of September 16, 2002, clearly establish that claim 12 is patentably distinct from that which is taught or suggested by Hinh et al. For all of these reasons, and the relevant remarks regarding claim 1, incorporated herein, Appellant believes the Examiner has failed to meet the

burden of establishing a *prima facie* case of obviousness. Accordingly, Appellant believes claim 12 is patentably distinct over the art of record. Most specifically, the art of record does not teach, at least, the acts of performing an initial screening of the potential customer and the issuance of an account number if the potential customer passes the initial screening, wherein the account number allows the potential customer further access to the automated seller facility, and to conduct a complete screening while simultaneously allowing the potential customer to place a product service order. This does not allow the customer to purchase the product, but merely allows the customer to place an order. One skilled in the art will readily recognize that if the complete screening is not favorable, the order will not be fulfilled.

Claims Dependent on Claim 12

Regarding claim 13, the Examiner failed to address each and every element of the claim. In fact, the Examiner never specifically addressed any element of claim 13. Claim 13, in part, calls for accepting a purchase offer “only after the complete screening of the potential customer indicates that the potential customer is authorized to purchase the products/services.” Simply, Hinh et al. does not teach accepting purchase offers only if the potential customer is authorized to purchase the desired product or service. Additionally, one of ordinary skill in the art will readily recognize that logins or credit checks do not determine whether the customer is authorized to purchase the product/service. That is, logins and credit checks are not product specific. While credit checks may be used to check whether the potential customer has sufficient credit to facilitate payment, one of ordinary skill in the art will readily recognize that credit checks may be price specific, but are not product specific. Therefore, a login or credit check would not determine authorization to purchase a product/service. This distinction is overly evident if the claims are interpreted in light of Appellant’s specification. As such, the Examiner has not established a *prima facie* case of obviousness. Appellant believes claim 13 is therefore patentably distinct over the art of record.

Regarding claim 14, the Examiner again failed to address each and every element of the claim. Claim 14, in part, calls for the automated seller facility to have

unrestricted and restricted product categories. Furthermore, the unrestricted product category includes products/services which may be purchased by a general group of buyers, and the restricted product category includes products/services pertaining to medical equipment. Again, nowhere does Hinh et al. teach or suggest product such categorization, nor does Hinh et al. teach or suggest the product categories be restricted and unrestricted. Furthermore, Hinh et al. does not teach or suggest predefined groups of buyers that are permitted to purchase from the categories. Additionally, Hinh et al. does not teach or suggest the restricted product category pertain to medical equipment. In fact, Hinh et al. does not teach, suggest or address medical equipment, or the special requirements of selling medical equipment, in any way. Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness. Claim 14 is also patentably distinct over the cited reference. It is believed that if the Examiner were to interpret the claims in light of the Appellant's specification, it would become apparent that the present invention defines over the art of record. However, it is apparent that the Examiner is interpreting the claims based on these prior art references, and stretching the interpretation of the claims to be melded into the prior art references. While Appellant acknowledges that the claims should be given their broadest reasonable interpretation, that interpretation must still be reasonable.

Regarding claim 15, the claim depends from claims 14 and, in part, specifies that an "authorized buyer" is a licensed health care professional, those that employ licensed health care professionals, or authorized health care distributors, in order to purchase from the restricted category. These are the types of "potential customers" that can be "qualified" in the initial screening. Hinh et al. does not teach, suggest, or even address categorization of products. Furthermore, Hinh et al. does not teach or suggest that a potential customer must be one of a specific criteria to purchase from a restricted category. Additionally, one of ordinary skill in the art will readily recognize that the Examiner's assertions regarding logins and credit checks are wholly irrelevant to the claimed elements of claims 14 and 15. Therefore, the Examiner has again failed to establish a *prima facie* case of obviousness. Accordingly, Appellant believes claim 15 is clearly patentably distinct over the art of record.

SINGH et al.

U.S. Serial No. 09/468,752

Regarding claim 16, the claim, in part, calls for the complete screening to include clearing any red flags. As previously addressed, Hinh et al. does not mention, teach, or suggest the use of any flags as part of any screening process. Also, the Examiner has failed to even address this or any specific element of claim 16. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness. Appellant believes claim 16 is clearly patentably distinct over the art of record.

Claim 17, in part, calls for the completed screening to include checking “whether the potential customer has changed any terms and conditions in the product/service order.” Hinh et al. does not teach or suggest any such screening or that such screening is to check “whether the potential customer has changed any terms and conditions in the product/service order.” Additionally, one of ordinary skill in the art will readily recognize that, contrary to the Examiner’s assertions, logins and passwords do not include checking “whether the potential customer has changed any terms and conditions in the product/service order.” Therefore, the Examiner has again completely failed to establish a *prima facie* case of obviousness, and therefore Appellant believes claim 17 is patentably distinct over the art of record.

Independent Claim 18

Regarding claim 18, the Examiner failed to address each and every element of this independent claim. Appellant incorporates herc in, the relevant remarks with respect to claims 1 and 12. Furthermore, claim 18, in part, calls for “a first tier computer system programmed to... initially screen the potential customer to allow further access” and “a second tier computer system programmed to... perform a complete screen of the potential customer.” While Hinh et al. may arguably teach some method of screening, i.e. with a login or credit check, Hinh et al. does not teach or suggest a two-tier computer system to complete two distinct screenings. That is, Hinh et al. does not teach a first computer system to implement a first screening and a second computer system to implement a second, more complete, screening. In fact, Hinh et al. teaches away from multiple computer systems by teaching a single computer system. *See* Fig. 1, numeral 2 of Hinh et al. Therefore, Appellant believes claim 18 is clearly patentably distinct over the art of record.

Claims Dependent on Claim 18

Claim 19, in part, calls for the automated seller facility to have unrestricted and restricted product categories. As previously discussed, Hinh et al. completely fails to teach or suggest restricted and unrestricted product categories. In fact, Hinh et al. fails to teach or suggest any categorization of products. Therefore, the Examiner has again failed to establish a *prima facie* case of obviousness and, therefore, Appellant believes claim 19 is patentably distinct from the art of record.

Claim 20, in part, calls for the restricted product category to include at least one of medical equipment and product/service information pertaining to medical equipment, and the authorized buyer to include licensed health care professionals, those employing licensed health care professionals, and authorized health care distributors. As previously shown, Hinh et al fails to teach or suggest product categorization including medical equipment and product/service information pertaining thereto. Furthermore, Hinh et al. fails to teach or suggest that an authorized buyer include licensed health care professionals, those employing licensed health care professionals, or authorized health care distributors. Also, one of ordinary skill in the art will readily recognize that such is inconsistent with logins and credit checks. Therefore, the Examiner has again failed to establish a *prima facie* case of obviousness and, therefore, Appellant believes claim 20 is patentably distinct from the art of record.

Regarding claim 21, the Examiner failed to address each and every element of the claim. Claim 21, in part, calls for "clearing any red flags." As previously indicated, nowhere in Hinh et al. are flags taught, nor is the clearing thereof even suggested. As such, Appellant incorporates the relevant remarks with respect to claims 7, 9, and 16 herein. The Examiner has again failed to address the element of "clearing red flags..." and, therefore, has failed to establish a *prima facie* case of obviousness. As such, Appellant believes claim 21 is patentably distinct from the art of record.

Claim 22, in part, calls for "the second tier computer system [to be] a globally-accessible computer network having global and regional processing centers." Hinh et al. does not teach or suggest such a two-tier computer system. *See* Fig. 1, numeral 2 of Hinh et al. Hinh et al. does not teach or suggest a second tier computer system have

SINGH et al.

U.S. Serial No. 09/468,752

the attributes called for in claim 22, i.e. have global and regional processing centers. In fact, Hinh et al. does not even suggest employing multiple processing centers at all. As such, the Examiner has again failed to establish any *prima facie* case of obviousness and Appellant asserts that claim 22 is patentably distinct over the art of record.

Claim 23, in part, calls for seller defined terms and conditions pertaining to a sale and a second tier computer system to determine "whether the potential customer has changed any of the terms and conditions, and if so, take[] action to ensure such changes are satisfactory to the seller." Hinh et al. teaches directly away from this element by allowing customer acceptance. Hinh et al. at ¶ [0023]. Specifically, Hinh et al. states that "[i]f the customer chooses to complete the purchase, the customer's acceptance is processed." *Id.* While Hinh et al. continues by checking seller information such as credit information, Hinh et al. does not teach allowing seller evaluation of customer changes to terms and conditions. *Id.* As such, the Examiner has failed to establish a *prima facie* case of obviousness. As such, Appellant believes claim 23 is patentably distinct over the art of record.

Conclusion of Issue No. 1:

Claims 1-23 are patentably distinct over Hinh et al. Hinh et al. does not teach, or even suggest each and every element of the claimed invention and the Examiner did not provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §2142 citing Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Therefore, since claims 1-23 are patentably distinct over the art of record, Appellant respectfully requests allowance of claims 1-23 over Hinh et al.

Issue No. 2:

Claims 1-23 were also rejected under 35 U.S.C. §103(a) as being unpatentable over another single reference, Westropc et al. The Examiner grouped claims 1-23 together. However, claims 1-23 are patentable because the Examiner has failed to establish a *prima facie* case of obviousness. Furthermore, claims 1-23 do not stand or fall together because, as will be shown below, claims 1, 2, 6-10, 12-21, and 23 include subject matter that is patentably distinct from the art of record. Accordingly, Appellant

SINGH et al.

U.S. Serial No. 09/468,752

respectfully believes that each of the above-identified claims must be reviewed independently to decide the appeal.

In the Office Action of July 15, 2002 the Examiner stated:

Westrope discloses an interactive computer system where a potential customer may view products and the customer is screened as to credit worthiness prior to authorizes a purchase. The complete screening is finished when the credit worthiness has been approved. It appears that to complete Westrope's sale an account number is opened. However, to have provided an account number to a potential customer would have been obvious to one of ordinary skill in the art. Doing so would use well known account databases to gain profile accounts of potential customers.

Pg. 2, ¶ 3, Ins. 2-8.

Claims 1-23 are patentable because the Examiner has failed to establish a *prima facie* case of obviousness. Again, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Aside from the unsupported allegations, the Examiner has failed to show that Westrope et al. teaches, or even suggests, the claimed invention. Furthermore, the Examiner has failed to provide a convincing line of reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the reference.

As Appellant explained in the Response of September 16, 2002, the system of Westrope et al. is simply an online computerized catalog system. Appellant stated:

Westrope et al. discloses a customer telephonically calling a business exchange that will manually transfer the call to allow a data link between the customer's processing unit and the various business servers. Once the telephonic data link is established between the computers, the customer has immediate access to display various catalog-available products.

Should the customer wish to purchase an item, Westrope et al. teaches the ability to handle purchase orders from the customer via a dedicated accounting and order processor. Col. 3, Ins. 52-59. Westrope et al. also discloses that the order is handled by electronically implementing typical "mail order processing procedures", which include a credit check. Col. 3-4, Ins. 63-2.

Response of September 16, 2002; pg 5, ¶ 2, Ins 3-10, emphasis added.

Independent Claim 1

Regarding claim 1, Westrope et al. does not teach the elements of claim 1. The Examiner contends that Westrope et al. teaches that "a potential customer may view products and the customer is screened as to credit worthiness prior to authorizing] a purchase," additionally, "[t]he complete screening is finished when the credit worthiness has been approved." Office Action of July 15, 2002, pg. 2, ¶ 3, lns 2-5. However, while Appellant does not disagree with the Examiner's statement, such is not the claimed invention. Claim 1, in part, calls for "receiving the customer data... performing an initial screening of the potential customer to determine whether the potential customer is qualified to purchase products/services from the seller... and issuing an account number if the potential customer passes the initial screening, thereby allowing the potential customer further access to the automated seller facility to make an offer to purchase products/services... while the automated seller facility performs a complete screening." In essence, claim 1 calls for a two-tier system whereby the potential customer is given access to products/services only if the first tier screening is first passed. Furthermore, a second tier of screening is performed while the potential customer is permitted to make an offer to purchase. While Westrope et al. does teach "mail order processing procedures", which include a credit check, Westrope et al. does not teach or suggest the two-tier system as claimed. *See* Cols. 3-4, lns. 63-2.

Unlike Westrope et al. where a customer is granted immediate access to the online catalog, claim 1 is clear that no potential customer can gain access to the automated seller facility without first passing the initial screening. *See* Westrope et al. Col. 3, lns. 5-27. The only screening disclosed by Westrope et al. is in conjunction with common mail order processing procedures at the conclusion of an order, which cannot be compared to the extensive two-tier screening called for in claims 1-23. *See* Westrope et al. Col. 3, ln. 52 to Col. 4, ln. 2.

Furthermore, as stated above when discussing Hinh et al., one of ordinary skill in the art will readily recognize that neither tier of screening called for in claim 1 is a mere credit check consistent with "mail order processing procedures." That is, one of ordinary skill in the art will recognize that "mail order processing procedures" do not

SINGH et al.

U.S. Serial No. 09/468,752

require the potential customer to pass an initial screening before making an offer to purchase, whereby a second, complete screening is performed.

Specifically, as one of ordinary skill in the art will readily recognize, credit worthiness cannot be checked until "the product" is identified and therefore, the product's price, is identified. That is, one of ordinary skill will readily recognize that one cannot determine whether a potential customer has sufficient credit to purchase "the product" until the price of "the product" is identified. However, claim 1 is specific that the second, complete screening occurs while the potential customer is permitted to make an offer to purchase. Simply, since claim 1, in part, calls for a complete check, not limited by credit worthiness, it is possible to implement the complete check while the potential customer makes an offer to purchase. Furthermore, Westrope et al. is specific that the credit check is consistent with "mail order processing procedures, as are known to those skilled in the direct marketing arts." Col. 3, lns. 63-65. One of ordinary skill in the art will readily recognize that such "mail order processing procedures" do not entail a two-tier screening system. Therefore, even if the "mail order processing procedures" may be construed as a complete screening, nowhere is an initial screening to determine authorization to purchase products/services taught, or suggested, by Westrope et al.

The Examiner states that "[i]t appears that to complete Westrope's sale an account number is opened." Office Action of July 15, 2002; pg. 2, ¶ 3, ln. 5. (Emphasis added) Appellant notes that the CFR, MPEP, and substantive case law are clear that "appearance" is not the standard for establishing a *prima facie* case of obviousness, but that teaching or suggesting is required. Nevertheless, assuming arguendo that Westrope et al. discloses issuance of an account number in conjunction with an established order, the account number does not serve to represent that a potential customer has previously passed the first of a two-tier screening system. Any account number issued in conjunction with the system of Westrope et al. would only apply to a previously completed order because the only screening taught by Westrope et al. is implemented "if a customer inquiry generates an order for a specific product listed in a retailer catalog." Col. 3, lns. 52-54. Therefore, the prior art of record does not teach, or suggest, the issuance of an account number allowing the potential customer access to the automated seller facility while the potential customer is allowed to make an offer to purchase – not

SINGH et al.

U.S. Serial No. 09/468,752

purchase, but merely make an offer to purchase. Furthermore, Westrope et al. does not teach or suggest that the automated seller facility performs a more complete screening following the initial screening, as called for in claim 1.

For all of the above reasons, claim 1 is patentably distinct from Westrope et al. Furthermore, Appellant believes claims 2-11 are also in condition for allowance pursuant to the chain of dependency. However, Appellant believes claims 2-11 include subject matter that is additionally distinguishable from the art of record. Therefore, Appellant will address that which is patentably distinct above and beyond the allowability of the claims pursuant to the chain of dependency. Appellant believes the following remarks provide the requisite explanation required to show that the claims of the group are separately patentable.

Claims Dependent on Claim 1

Referring to claim 2, Westrope et al. fails to teach "accepting the potential customer's offer to purchase products/services only if the potential customer passes the complete screening and thereby only entering into a contract with the potential customer once the seller is satisfied the potential customer is qualified to purchase the products/services." Simply, Westrope et al does not teach the use of such contracts. Therefore, the Examiner has failed to meet the burden required to establish a *prima facie* case of obviousness. Accordingly, Appellant believes claim 2 is patentably distinct over the art of record.

Claim 6, in part, calls for "an electronic contract" and "sending the account number, together with a password, and an electronic contract to the potential customer after the potential customer has passed the initial screening." Not only does Westrope et al. not teach the use of such contracts, it does not teach sending a contract to a potential customer along with an account number and password. Furthermore, Westrope et al. does not teach any such steps, as claimed in claim 3, to be completed "after the potential customer has passed the initial screening" because Westrope et al does not teach an initial screening. For these reasons, Appellant believes claim 6 is patentably distinct over the art of record.

Claim 7, in part, calls for "segregating products/services into restricted and unrestricted product categories." Nowhere in Westrope et al. is product/service segregation taught nor are restricted and unrestricted product categories taught or suggested. The Examiner failed to even address the elements of claim 7. The Examiner has never, in three separate actions, addressed "segregating products/services into restricted and unrestricted product categories."

Additionally, claim 7, in part calls for "checking the customer data to clear any red flags." Nowhere in Westrope et al. are flags taught nor is the clearing thereof even suggested. The Examiner has entirely neglected to even address the checking and/or clearing of flags in any action. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. Claim 7 is patentably distinct over the art of record.

Claim 8, in part, calls for the restricted product category to include "at least one of: medical equipment, product/service information pertaining to medical equipment, and medical equipment service." As previously stated, Westrope et al. does not teach restricted product categories. Furthermore, Westrope et al. does not teach medical equipment, product/service information pertaining to medical equipment, and medical equipment service or the special problems of selling such goods and services. The Examiner did not address the elements of claim 8.

Claim 9, in part, again calls for the clearing of red flags. As previously stated, Westrope et al. does not teach, or suggest, the use of flags. As such, Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness and that claim 9 is patentably distinct from the art of record.

Claim 10, in part, calls for the complete screening to include "chccking whether the potential customer has changed any terms and conditions defined by the seller in an offer to purchase products/services, and if so, ensuring that such changes are satisfactory to the seller." Again, the Examiner failed to provide a detailed basis of rejection of claim 10. Westrope et al. does not teach that which is claimed. Furthermore, one of ordinary skill in the art will readily recognize that "mail order processing procedures" generally do not include allowing the customer to change terms

and conditions of the sale. That is, allowing such would be inconsistent with a mail order because it would require multiple mailings, i.e. the contact to the buyer, the changed contact to the seller and then notice that the changes are satisfactory. Simply, "mail order processing procedures" are focused on recreating a simple retail transaction at a store through the mail. Therefore, one of ordinary skill in the art will recognize that that which is claimed is well beyond ordinary "mail order processing procedures." As such, *Appellant* believes claim 10 is patentably distinct from the art of record.

Independent Claim 12

Regarding claim 12, the Examiner also failed to address each and every element of the claim. That is, claim 12 was included in the Examiner's rejection of claims 1-23 and addressed in the general remarks stated above. However, the Examiner did not address a single specific element of claim 12.

In response to the Examiner's general rejection of claims 1-23 in the Office Action of July 15, 2002, Appellant addressed numerous specific elements of claim 12 that are patentably distinct from the art of record. Specifically, Appellant stated:

As for claim 12, the prior art of record does not teach, nor suggest, conducting a more complete screening while simultaneously allowing the potential customer to place a product/service order, and the issuance of an account number between the performance of an initial screening and before a more complete screening is conducted.

Additionally, Appellant does not dispute that "it appears that to complete Westrope's sale an account number is opened" as opined by the Examiner. However, Westrope fails to teach or suggest issuance of an account number prior to completion of a purchase for goods/services. Appellant agrees that it is commonplace to issue an account number once a sale is complete, but the art of record neither teaches nor suggests issuance of an account number before a sale is complete. Moreover, the art fails to teach or suggest issuance of an account number following an initial screening to thereby allow a potential and qualified customer to purchase goods/services while a second, more complete screening is performed.

Response of September 16, 2002.

In response to Appellant's remarks, the Examiner simply stated that "Appellant's comments regarding claim 12 are noted, but not convincing as no such claim limitations are present in the claims as so argued in the REMARKS." Office

Action of December 3, 2002: pg. 3, ¶ 1, lns. 3-6. "In sum, Appellant is asserting positions that are not supported by the present invention as claimed." *Id.* at pg. 3, ¶ 1, lns. 5-6.

As stated with respect to the rejection based on *Hinh et al.*, Appellant respectfully disagreed with the Examiner but was unable to directly address the specific limitations the Examiner asserted were not present in the claims because the Examiner did not specify what limitations were absent. Furthermore, Appellant believes that all limitations are, and were, present in claim 12, as argued. The art of record does not teach, or suggest conducting a more complete screening while simultaneously allowing the potential customer to place a product/service order. This is specifically called for in the last element of claim 12. Further, the art does not disclose, or suggest the issuance of an account number between the performance of an initial screening and before a more complete screening is conducted – this is called for in the second to last element of claim 12. Appellant calls for the issuance of an account number that allows the potential customer to further access the automated seller facility that therefore dictates that the issuance of an account number is made prior to the completion of a purchase for goods/services. The Examiner has completely failed to address any of these distinctions. The Examiner ignores the distinctions, and manipulates the claims in an attempt to make the claims read on the prior art. The claims are to be interpreted based on Appellant's specification, not the prior art specification. For all of these reasons and the relevant remarks regarding claim 1, incorporated herein, Appellant believes the Examiner has again failed to meet the burden of establishing a *prima facie* case of obviousness. Accordingly, Appellant believes claim 12 is patentably distinct from the art of record.

Claims Dependent on Claim 12

Regarding claim 13, the Examiner failed to address the specific elements of the claim. Claim 13, in part, calls for accepting a purchase offer "only after the complete screening of the potential customer indicates that the potential customer is authorized to purchase the products/services." One of ordinary skill in the art will readily recognize that credit checks consistent with "mail order processing procedures" do not determine

SINGH et al.

U.S. Serial No. 09/468,752

whether the customer is authorized to purchase the product/service. *See* Westrope et al. Col. 3, ln. 47 to Col. 4 ln. 2. While credit checks may be used to check whether the potential customer has sufficient credit to facilitate payment, one of ordinary skill in the art will readily recognize that credit checks are price specific, not product specific. Therefore, a credit check does not determine authorization to purchase a product/service. Again, Appellant is not claiming a credit check but a second, complete screening, after the initial screening, that Appellant has shown to be beyond the scope of a credit check and wholly inconsistent with ordinary "mail order processing procedures." As such, Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Appellant believes claim 13 is patentably distinct from the art of record.

Claim 14, in part, calls for the automated seller facility to have unrestricted and restricted product categories. Furthermore, the unrestricted product category includes products/services which may be purchased by a general group of buyers, and the restricted product category includes products/services pertaining to medical equipment. Again, Westrope et al. does not teach or suggest product categorization nor does it teach or suggest the product categories be a restricted category and an unrestricted category. Furthermore, Westrope et al. does not teach or suggest groups of buyers that are permitted to purchase from the categories. Westrope et al. does not teach, suggest or address the elements. Appellant believes the Examiner has wholly failed to establish a *prima facie* case of obviousness. Claim 14 is clearly patentably distinct over Westrope et al.

Claim 15, in part, calls for the potential customer to be a licensed health care professional, those that employ licensed health care professionals, or authorized health care distributors, in order to purchase from the restricted category. Again, Westrope et al. does not teach or suggest that a potential customer must be a one of a specific criteria to purchase from a restricted product/service category. To the contrary, Westrope et al. is directed to attracting a wide range of customers. *See* Westrope et al. Col. 2, lns 7-22. Specifically, Westrope et al. makes numerous allusions to the benefits of its system as allowing new international customers, e.g. Canadians, to access and

purchase from the online catalog. *See* Background of the Invention of Westrope et al. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, claim 15 is patentably distinct over the art of record.

Claim 16, in part, calls for the complete screening to include clearing any red flags. As previously addressed, Westrope et al. does not teach or suggest the use of any flags as part of any screening process. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness. As a result, Appellant believes claim 16 is patentably distinct from the art of record.

Claim 17, in part, calls for the complete screening to include checking "whether the potential customer has changed any terms and conditions in the product/service order." Westrope et al. does not teach or suggest any such screening or that such screening is to check "whether the potential customer has changed any terms and conditions in the product/service order." As previously stated, allowing a customer to change any terms and conditions would be inconsistent with typical "mail order processing procedures." *See* Westrope et al. Col. 3, ln. 47 to Col. 4, ln. 2. One skilled in the art would surmise that contract terms from a system such as Westrope et al. could only be accepted or declined. That is, online sellers, and more particularly mail order sellers, typically provide either an accept or reject of the terms, and not allow modification thereof. Westrope et al. does not teach, nor suggest, modification of terms and conditions. Therefore, the Examiner has again wholly failed to establish a *prima facie* case of obviousness and therefore Appellant believes claim 17 is patentably distinct from the art of record.

Independent Claim 18

Regarding claim 18, the Examiner has failed to address the specific elements of the claim. Appellant incorporates herein, the relevant remarks with respect to claims 1 and 12. Furthermore, claim 18, in part, calls for "a first tier computer system programmed to... initially screen the potential customer to allow further access" and "a second tier computer system programmed to... perform a complete screen of the potential customer." The Examiner asserts that "[a]n initial screening may be no more than placing a[n] person/entities name on a credit application." Office Action of

SINGH et al.

U.S. Serial No. 09/468,752

December 3, 2002; pg. 2, ¶ 2, lns. 5-6. However, Westrope et al. does not teach any such credit applications. The Examiner makes assertions that are not supported by the references, and therefore, must be disregarded. Furthermore, one of ordinary skill in the art will readily recognize that any such credit application would be inconsistent with "mail order processing procedures" because such a retail catalog mail orders do not include credit applications. The Examiner is not permitted to impute teachings not supported by the reference. Therefore, Appellant believes claim 18 is patentably distinct from the art of record.

Claims Dependent on Claim 18

Claim 19, in part, calls for the automated seller facility to have unrestricted and restricted product categories. As previously discussed, Westrope et al. fails to teach or suggest restricted and unrestricted product categories. Therefore, the Examiner has again completely failed to establish a *prima facie* case of obviousness and as a result, Appellant believes claim 19 is patentably distinct over the art of record.

Claim 20, in part, calls for the restricted product category to include at least one of medical equipment and product/service information pertaining to medical equipment, and the authorized buyer to include licensed health care professionals, those employing licensed health care professionals, and authorized health care distributors. As previously shown, Westrope et al. fails to teach or suggest product categorization including medical equipment and product/service information pertaining thereto. Also, Westrope et al. fails to teach or suggest that an authorized buyer include licensed health care professionals, those employing licensed health care professionals, and authorized health care distributors. As stated, Westrope et al. teaches away from limiting or restricting customers because the very purpose of the invention of Westrope et al. is to attract a wide array of new customers to the online catalog. *See* Westrope et al. Col. 1, ln. 11 to Col. 2, ln. 22. Therefore, the Examiner has again failed to establish a *prima facie* case of obviousness. Claim 20 is patentably distinct from the art of record.

Claim 21, in part, calls for "clearing any red flags." As previously indicated, nowhere in Westrope et al. are red flags taught nor is the clearing thereof suggested. As such, Appellant incorporates the relevant remarks with respect to claims 7, 9, and

SINGH et al.

U.S. Serial No. 09/468,752

16 herein. The Examiner has again failed to address the element of "clearing red flags..." and, therefore, has failed to establish a *prima facie* case of obviousness. As such, Appellant believes claim 21 is patentably distinct over the art of record.

Claim 23, in part, calls for seller defined terms and conditions pertaining to a sale, and to the second tier computer system to determine "whether the potential customer has changed any of the terms and conditions, and if so, take[] action to ensure such changes are satisfactory to the seller." Again, the cited element is inconsistent with anything taught by Westrope et al., and is inconsistent with "mail order processing procedures" taught by Westrope et al. and, therefore, the rejection is wholly unsupported by Westrope et al. *See* Westrope et al. Col. 3, ln. 47 to Col. 4, ln. 2. As such, the Examiner has again failed to establish a *prima facie* case of obviousness. Appellant believes claim 23 is patentably distinct over the art of record.

Conclusion of Issue No. 2:

Claims 1-23 are patentable because the Examiner has failed to establish a *prima facie* case of obviousness. Simply, Westrope et al. does not teach or suggest the elements and the Examiner did not provide a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *See* MPEP §2142 and *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Therefore, claims 1-23 are patentably distinct from the art of record. As such, Appellant respectfully requests allowance of claims 1-23.

9. CONCLUSION

In view of the above remarks, Appellant respectfully submits that the Examiner has provided no supportable position or evidence that claims 1-23 are obvious under §103(a). Accordingly, Appellant respectfully requests that the Board find claims 1-23 patentable over the prior art of record and withdraw all outstanding rejections.

General Authorization for Extension of Time

In accordance with 37 C.F.R. §1.136, Appellant hereby provides a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefore. Furthermore, Appellant authorizes the Commissioner to charge deposit account no. 07-0845 the appropriate fee for an extension of time or any

SINGH et al.

U.S. Serial No. 09/468,752

other fee which may be currently due, including the \$320.00 fee for filing this Appcal
Brief Under 37 C.F.R. §1.17(c).

Respectfully submitted,



Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-376-5139
tjz@zpspatents.com

Dated: May 5, 2003
Attorney Docket No.: **Old:** GEM-30890
New: GEMS8081.028

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, LLC
14135 N. Cedarburg Rd.
Mequon, WI 53097-1416
262-376-5170

10. APPENDIX OF CLAIMS ON APPEAL

1. A method of screening a potential customer and assigning an account number to the potential customer over a computer network, the method comprising the steps of:

providing a user interface for a potential customer to access an automated seller facility, the access taking place over a computer network, the user interface allowing the customer to enter customer data for qualification by checking by a seller;

receiving the customer data from the customer in the automated seller facility via the user interface and over the computer network;

performing an initial screening of the potential customer to determine whether the potential customer is qualified to purchase products/services from the seller; and

issuing an account number if the potential customer passes the initial screening, thereby allowing the potential customer further access to the automated seller facility to make an offer to purchase products/services from the automated seller facility while the automated seller facility performs a complete screening.

2. The method of claim 1 further comprising the steps of performing a complete screening in order to authorize the potential customer to actually purchase products/services from the automated seller facility if the potential customer is so qualified, accepting the potential customer's offer to purchase products/services only if

the potential customer passes the complete screening and thereby only entering into a contract with the potential customer once the seller is satisfied the potential customer is qualified to purchase the product/services, and declining the potential customer's offer to purchase if the potential customer is not qualified by the seller.

3. The method of claim 1 further comprising the steps of receiving an existing account number and providing a pre-populated user interface in response thereto having existing customer data therein, and requiring verification of the existing customer data by the potential customer, thereby bypassing the initial screening step.

4. The method of claim 1 further comprising the step of periodically querying accuracy of customer data from existing customers, and updating a database if any changes are found.

5. The method of claim 4 wherein the customer data comprises information provided by the potential customer during a previous transaction with the seller, the seller having stored the information in the database.

6. The method of claim 1 further comprising the step of sending the account number, together with a password, and an electronic contract to the potential customer after the customer has passed the initial screening.

7. The method of claim 1 further comprising the steps of segregating products/services into restricted and unrestricted product categories within the automated seller facility and wherein the initial screening comprises determining whether the potential customer is an authorized buyer of products from the restricted product category, and checking the customer data to clear any red flags, such as inconsistent billing and shipping addresses.

8. The method of claim 7 wherein the restricted product category includes at least one of: medical equipment, product/service information pertaining to medical equipment, and medical equipment service.

9. The method of claim 1 wherein the complete screening comprises clearing any red flags, including checking whether the potential customer has included a method of payment with an offer to purchase products/services, and if so, determining whether the method of payment is an authorized method of payment for that customer.

10. The method of claim 1 wherein the complete screening comprises checking whether the potential customer has changed any terms and conditions defined by the seller in an offer to purchase products/services, and if so, ensuring that such changes are satisfactory to the seller.

11. The method of claim 1 wherein the user interface includes a plurality of required fields and wherein the method further includes the step of confirming that each

required field in the user interface has been completed, and if not, restricting access by the potential customer until all required fields are complete.

12. A computer readable medium having stored thereon a computer program which, when executed by one or more computers, causes the one or more computers to:

acquire customer information at an automated seller facility from a potential customer through a user interface;

perform an initial screening of the potential customer;

issue an account number if the potential customer passes the initial screening, the account number allowing the potential customer to further access the automated seller facility; and

conduct a complete screening while simultaneously allowing the potential customer to place a product/service order.

13. The computer program on the computer readable medium of claim 12 wherein the product/service order is a purchase offer in which the potential customer offers to purchase products/services, and wherein an acceptance of the purchase offer occurs only after the complete screening of the potential customer indicates that the potential customer is authorized to purchase the products/services.

14. The computer program on the computer readable medium of claim 12 wherein the automated seller facility has unrestricted and restricted product categories, the unrestricted product category comprising products/services which may be purchased

by a general group of buyers, and the restricted product category comprising products/services pertaining to medical equipment.

15. The computer program on the computer readable medium of claim 14 whercin the potential customer must be an authorized buyer of restricted product category products/services, and is further defined to include licensed health care professionals, those entities that employ licensed health care professionals, and authorized health care distributors.

16. The computer program on the computer readable medium of claim 12 wherein the computer screening comprises clearing any red flags, including at least checking whether the authorized potential customer has provided a method of payment with the product/service order, and if so, checking whether the method of payment is an authorized method of payment.

17. The computer program on the computer readable medium of claim 12 whercin the completed screening comprises at least checking whether the potential customer has changed any terms and conditions in the product/service order, and if so, ensuring that such changes are satisfactory to the seller.

18. A network-based system for screening a potential customer and assigning an account number to the potential customer comprising:

an automated seller facility having a supplier network of computers including:

a first tier computer system programmed to:

receive customer data from a customer accessible computer;

confirm that the customer data is complete;

initially screen the potential customer to allow further access;

issue an account number if the potential customer is determined qualified wherein the potential customer is allowed further access to the automated seller facility; and

a second tier computer system programmed to receive the customer data from the first tier computer system and perform a complete screen of the potential customer while the potential customer is allowed further access to the automated seller facility to place an offer to purchase products/services from the automated seller facility.

19. The network-based system of claim 18 wherein the automated seller facility has unrestricted and restricted product categories, and wherein the second tier computer system is programmed to determine whether the products/services that the potential customer offers to purchase are from the restricted product category, and if so, the second tier computer system is further programmed to check the potential customer is an authorized buyer of such restricted products/services.

20. The network-based system of claim 19 wherein the restricted product category comprises at least one of: medical equipment and product/service information pertaining to medical equipment, and the authorized buyer is further defined to include licensed health care professionals, those employing licensed health care professionals, and authorized health care distributors.

21. The network-based system of claim 18 wherein the complete screening comprises clearing any red flags, including checking whether an authorized potential customer has identified a method of payment and determining whether the method of payment is an authorized method of payment.

22. The network-based system of claim 18 wherein the second tier computer system is a globally-accessible computer network having global and regional processing centers.

23. The network-based system of claim 18 wherein the seller defines terms and conditions pertaining to a sale of products/services to the potential customer, and wherein the second tier computer system determines whether the potential customer has changed any of the terms and conditions, and if so, takes action to ensure such changes are satisfactory to the seller.